

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed November 10, 2003. At the time of the Office Action, Claims 1-32 were pending in the Application. Applicant amends Claims 9 and 32. The amendments are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Applicant's amendments are without prejudice or disclaimer. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Consideration of Information Disclosure Statement

Applicant has submitted an Information Disclosure Statement (IDS) with this Response. Applicant respectfully requests the Examiner to review this IDS and to formally indicate that these materials have been considered in the context of the pending prosecution. Applicant suggests the Examiner use a PTO Form 1449 to provide written notification to this effect.

Section 102 Rejection

The Examiner rejects Claims 9, 11, 13, 14, and 15 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,475,679 issued to Munter (hereinafter "*Munter*"). This rejection is respectfully traversed for the following reasons.

Independent Claim 9, as amended, recites:

19. An apparatus for communicating data, comprising:
a multiplexer operable to receive one or more words associated with a respective one of a first and a second set of data, wherein the first and second sets of data are associated with a first channel and a second channel respectively;
first and second memory banks each coupled to the multiplexer and each operable to receive one or more of the words from the multiplexer; and
a scheduler coupled to each of the first and second memory banks and operable to monitor the first and second memory banks in order to read one or more cells out of a selected one of the first and second memory banks, wherein each of the cells comprises a plurality of the words from a respective one of the first and second sets of data.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition,

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

"[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Using the preceding well-settled jurisprudence, it is clear that *Munter* fails to anticipate Independent Claim 9. For example, *Munter* fails to teach, suggest, or disclose a scheduler coupled to each of the first and second memory banks and operable to monitor the first and second memory banks in order to read one or more cells out of a selected one of the first and second memory banks, as recited in Independent Claim 9. Indeed, the Examiner concedes as much in concluding: "*Munter* also does not teach the steps of monitoring the memory to determine when enough of the words have formed cells." (See Office Action of November 10, 2003: pages 4-5.) Thus, the Examiner acknowledges the deficiencies of *Munter*. Accordingly, Independent Claim 9 is patentable over *Munter*. Additionally, Independent Claim 32 recites a similar limitation and is also allowable for analogous reasons. In addition, claims 10-15 depend from Claim 9 and are, therefore, also patentable over *Munter* for at least these reasons. Notice to this effect is respectfully requested.

Section 103 Rejections

The Examiner rejects Claims 1-5, 7, and 8 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of U.S. Patent No. 5,583,894 issued to Linsley (hereinafter "*Linsley*") and further in view of U.S. Patent No. 5,892,764 issued to Riemann et al. (hereinafter "*Riemann*"). The Examiner rejects Claim 6 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and *Riemann* as applied to Claim 5 above and further in view of U.S. Patent Application Publication No. 2003/0165147 (hereinafter "*Shimada*"). The Examiner rejects Claims 10 and 12 under 35 U.S.C. §103(a) as being

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

unpatentable over *Munter* in view of U.S. Patent No. 6,094,430 issued to Hoogenboom (hereinafter "*Hoogenboom*"). The Examiner rejects Claims 16-20, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and further in view of *Riemann*. The Examiner rejects Claim 21 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and *Riemann* as applied to Claim 20 above and further in view of *Shimada*. The Examiner rejects Claims 24-28, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and further in view of *Riemann*. The Examiner rejects Claim 29 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Linsley* and *Riemann* as applied to Claim 24 and further in view of *Shimada*. The Examiner rejects Claim 32 under 35 U.S.C. §103(a) as being unpatentable over *Munter* in view of *Hoogenboom*. Applicant respectfully traverses these rejections for the reasons provided below.

Applicant notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.⁵ As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

Independent Claim 1 recites, in part, monitoring the first and second serial-to-parallel converters in order to determine when one or more words of the respective data sets have accumulated in each of the first and second serial-to-parallel converters; writing one or more of the words that have accumulated in each of the first and second serial-to-parallel converters to a selected one of first and second memory banks; and monitoring, by a single scheduler, the first and second memory banks to determine when enough of the words that were written to each of the first and second memory banks have formed one or more cells.

These teachings are simply not found in *Munter*, or in any of the other cited references for the §103 rejection. In contrast to the teachings of Independent Claim 1, *Munter* discloses a high capacity ATM switch for switching data between input ports and output ports in a variable length train of digital cells, each input and output port handling one

⁵ See generally M.P.E.P. §2143.

or more channels and each cell comprising a fixed number of bytes and including a channel indication therein. The switch includes an input buffer at each input port for separately storing trains of digital cells destined for output ports and for sending a connection request through a control link to switch core means. In response to the connection request from one or more input buffers, the switch core means makes and breaks high speed data link connections between the input ports and the output ports at desired times and indicates by way of the control link to each input buffer when to send the train of digital cells stored therein. The switch also includes an output buffer at each output port which separately stores cells of bytes received from the switch core means and destined to the channel in response to the channel indication of each cell. (See *Munter*, Column 2, lines 42-60.)

For the teaching of the monitoring operations, as recited in Independent Claim 1, the Examiner has failed to point out anything in *Munter* that is germane to the patentability of the pending claims. Instead, the Examiner improperly refers to the potential for such an operation in *Linsley*. Such tenuous and speculative propositions cannot be sustained as a basis for a proper §103 analysis. Evaluating the passage referred to by the Examiner more closely reveals that the teachings of *Linsley* could not possibly inhibit the patentability of Independent Claim 1.

Linsley discloses that the overlap of the address counters in the preferred embodiment is possible without data corruptions because address counters 23 and 24 count data units. The most significant six bits of the data unit count is used as a dual port memory address to address memory locations in dual port memory 25. The least significant three bits refer to the data unit (bits) within each memory location. Address comparator 55 compares only the six-bits of the dual port memory addresses. Thus, comparator 55 will find an address difference between addresses in address counter 23 and address counter 24 of zero when input counter 23 is counting the first data unit within a particular eight bit word to be stored in dual port memory 25 and output counter 24 is counting a last data unit in a word currently stored in dual port memory 25 at the address to be written by input counter 23. There is no conflict because the new data is not written into dual port memory 25 until all the data units for the eight-bit word have been accumulated by serial to parallel logic 21. Thus, provided there are no pauses in clock 15, the output counter 24 will complete reading out the last unit of data in the eight-bit memory location before all the data units for the new eight-bit word is accumulated and written into the memory location. In embodiments of *Linsley* where the

data unit is the same width as data words stored in dual memory port 25, address counter 23 and address counter 24 are not allowed to overlap. Additionally, in such cases, serial to parallel logic 21 and parallel to serial logic 26 are unnecessary. (See *Linsley*, Column 7, lines 10-36.)

The Examiner has unfairly extracted a single sentence from the passage of *Linsley* in an effort to combine its irrelevant teachings with the subject matter of *Munter*. *Linsley* does not relate to monitoring as disclosed by Independent Claim 1. Instead, as evidenced above, *Linsley* deals with an arbitrary capacity in the context of a different type of communications architecture. For at least this reason, Independent Claim 1 is patentable over the proposed *Munter-Linsley*. Additionally, Independent Claims 16 and 25 recite a limitation that is similar to that identified above and are, therefore, also patentable over the proposed combinations for analogous reasons.

In addition, Applicant notes that with respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.⁶ Thus, the fact that the teachings of one reference (*Munter*) would improve the teachings of any other reference (*Linsley*, *Riemann*, *Shimada*, or *Hoogenboom*), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Munter* or in any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications.⁷ The Examiner merely speculates that "it would have been obvious" to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required

⁶ See M.P.E.P. §2143.01.

⁷ The Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

by Federal Circuit case law.⁸ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁹

Furthermore, the Examiner is precluded from modifying the combined teachings of *Munter*, *Linsley*, *Riemann*, *Shimada*, and *Hoogenboom* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹⁰ The fact that the modification is possible or even advantageous is not enough.¹¹ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹²

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Munter* and any of the references of record would not be capable of performing the operations required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Munter* could provide a communications architecture capable of offering any of the monitoring functions identified above; nor is there any disclosure relating to the other elements identified in the pending claims in the analysis provided supra. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Munter-Linsley*, *Riemann*, *Shimada*, or *Hoogenboom* combinations would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits

⁸ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not "evidence." *Id.*

⁹ See M.P.E.P. §2145. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references."); see also *In re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].")

¹⁰ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹¹ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹² *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly in the tendered analysis provided supra by the Applicant. With no other supporting references that are combinable with *Munter*, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combination. Therefore, Applicant respectfully submits that claims 1-32 are patentably distinct from the proposed combinations. All of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-32.


CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

The required fee of \$180.00 is submitted herewith for the IDS and is believed to be correct. However, if this is not correct, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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